

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

5607-3

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on 2010-10-28

Signature /Leslie M. Frankel/Typed or printed name Leslie M. Frankel

Application Number

10/598,788

Filed

2007-05-31

First Named Inventor

Manfred Michalk

Art Unit

2887

Examiner

LEE, SEUNG H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.
/Matthew R. Ellsworth/
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Matthew R. Ellsworth

Typed or printed name

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☐ attorney or agent acting under 37 CFR 1.34.
2010-10-28

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Appl. No.: | 10/598,788 |) | Confirmation No.: | 1394 |
| | |) | | |
| Applicant: | Michalk, Manfred |) | Art Unit: | 2887 |
| | |) | | |
| Filed: | 05/03/2007 |) | Examiner: | Lee, Seung H. |
| | |) | | |
| Docket No.: | 5607-3 |) | | |
| | |) | | |
| For: | FLAT TRANSPONDER AND |) | | |
| | METHOD FOR THE |) | | |
| | PRODUCTION THEREOF |) | | |

Filed Electronically

REASONS SUPPORTING PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner rejects claims 1-4 and 6-18 under 35 U.S.C. §103(a) as being unpatentable over US 2003/0132302 to Hattori ("Hattori") in view of US 2001/0040186 to Okada ("Okada"). The Examiner also rejects claim 5 under 35 U.S.C. §103(a) as being unpatentable over Hattori, Okada, and US 5,936,227 to Truggelmann et al. ("Truggelmann"). Applicants respectfully submit that the rejections of these claims should be reconsidered and withdrawn for at least the following reasons.

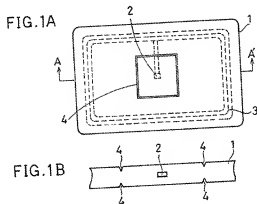
Hattori, Okada, and Truggelmann do not disclose elements of pending claims

When determining whether a claim is obvious under 35 U.S.C. § 103, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (holding that to establish prima facie obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art)). Applicants respectfully submit that several features in the independent claims are neither taught nor suggested, either expressly or inherently, in any of the cited prior art references. Accordingly, for at least the reasons below,

Applicants submit that the rejections of the claims under 35 U.S.C. § 103 should be reconsidered and withdrawn.

The present invention is directed, in one embodiment, toward a flat transponder having an electronic circuit with at least one chip and conductor wires arranged in a layer wherein the circuit is arranged in or on a carrier made of plastic. On the outer surfaces of the flat transponder a paper layer is applied, wherein notches are made in at least one paper layer. The notches, which increase flexibility of the transponder, are applied at different intervals and/or with a different depth to create surface regions of different flexibility and/or flexibility directions.

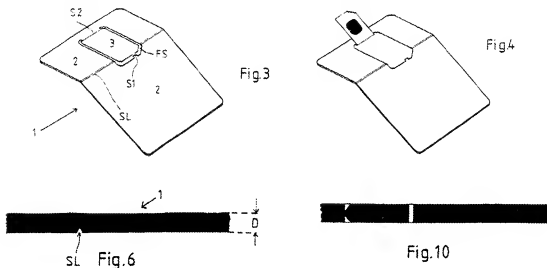
The Examiner has acknowledged that Hattori does not teach the use of notches which increase the flexibility of an IC card. Neither Okada nor Truggelmann overcome the shortcomings of Hattori. The Examiner has applied Okada as disclosing use of notches to improve flexibility of an IC card. Okada teaches a single groove forming a perimeter directly around the IC chip used as the means to suppress bending force of the IC card. This is not similar in any manner to features claimed in independent Claim 1. Okada provides no disclosure to form regions with different flexibilities or different flexibility directions with different distances between the grooves as in the present application.



In addition, the Examiner has acknowledged that a combination of Hattori and Okada do not teach the use of notches which penetrate through a paper layer and into the adjacent layer. Neither Okada nor Truggelmann overcome the shortcomings of Hattori. The Examiner asserts that Truggelmann discloses a notch applied to a card that penetrates through a paper layer and into the adjacent layer, and summarily rejects Claim 5 under 35 U.S.C. §103(a) as being unpatentable over Hattori, Okada, and Truggelmann.

Truggelmann is generally related to a plastic card (1) having a carrier card (2) for separately holding a minichip card (3), containing a defined breaking line (SL) to allow the

minichip card to “be broken out easily” (see Col. 3, ll. 6-7). See Fig. 3 and Fig. 4 inserted below. Truggelmann teaches a singular V-shaped notch of uniform depth and location (see for example Fig. 6 inserted below) or other shapes of uniform intervals and uniform depths. (See for example Fig. 10 inserted below). However, there is no teaching of notches of different depths to create regions of different flexibility, as disclosed in Applicant’s invention. Accordingly, Applicants respectfully submit that the rejections of claims 1 and 5 should be reconsidered and withdrawn.



Hattori, Okada, and Truggelmann teach away from the claimed invention

A reference that “teaches away” from a given combination may negate a motivation to modify the prior art to meet the claimed invention. *Ormco Corp. v. Align Technology, Inc.*, 463 F.3d 1299, 1308 (Fed. Cir. 2006). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *Ormco*, 463 F.3d at 1308 (citing *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006)).

Not only does Hattori not teach the use of notches which increase the flexibility of an IC card, but Hattori explicitly teaches away from the use of notches. Hattori teaches a layered IC card comprising a core layer with an antenna and IC chip, wherein the core layer is between a first and second layer. The Hattori card “exhibits excellent smoothness” [0012] in order to accommodate face images and writing on the outside layers. (see Fig. 23(c) inserted below). Further, Hattori teaches use of a “photocurable resinous layer, as a protective layer of the image recording body” [0138] (See also Fig.23(a) inserted below). Hattori has no teaching to provide notches in any of its outer layers, and indeed, teaches away from adding any notches or

indentations because such a feature would vitiate Hattori's objective of providing an ID card with "excellent smoothness" [0012] and disturb the image and writings on the card, as deliberately protected by the protection layer [0138].

Since Hattori teaches away from the claimed invention, Applicants respectfully submit that Hattori cannot be properly relied upon in constructing an obviousness rejection of the pending claims. As such, the rejection of claim 1 as being obvious over Hattori in view of any other reference should be reconsidered and withdrawn.

FIG. 23 (c)

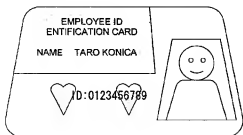
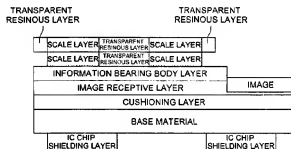


FIG. 23 (a)



Similarly, Okada and Truggelmann not only do not teach the concealment of the IC chip, they explicitly teach away from concealment by identifying the chip location. It is one aim of the present invention to avoid giving this position (see the application as filed paragraphs [0015] and [0029]). Okada teaches the means used to suppress bending force to the IC chip directly around the chip (see for example Figure 1A inserted previously above) thus giving the exact position of the IC chip. Further, the breaking line (SL) of Truggelmann is "interrupted by the cut-free portion along the outer contour of minichip card" (Col. 3, ll. 24-27), thereby identifying the location of the chip and thus, like Okada, teaching away from Applicant's invention wherein the identification of the chip is intentionally avoided.

In addition, Truggelmann teaches a notch (SL) designed to allow a card to be broken, not to allow a card to be flexible, and thus teaches away from Applicant's invention.

Combination of Hattori, Okada, and Truggelmann is improper as explicit teachings of Hattori contradict asserted teachings of Okada and Truggelmann

Care must be taken to avoid hindsight reconstruction by combining just the right references in just the right way so as to achieve the result of the claimed invention. *Grain Processing Corp. v. American Maize Products Company*, 840 F.2d 902, 907 (Fed. Cir. 1988).

One cannot merely pick and choose individual elements from multiple references to recreate the invention. *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1571 (Fed. Cir. 1986).

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then the combination or modification cannot be held obvious. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

The Examiner has asserted that the claimed invention would be obvious based on the combination of Hattori and Okada and further asserts that “it would be obvious to one of ordinary skill in the art to incorporate the teachings of Okada to the teachings of Hattori in order to improve the flexibility of the card when the card is forced to bend.” Applicant respectfully disagrees with this assertion and respectfully submits that the combination of Hattori and Okada results in improper hindsight. Hattori expressly teaches use of a “photocurable resinous layer, as a protective layer of the image recording body” [0138] and has as an objective to provide an ID card with excellent smoothness.

The Examiner suggests that one of ordinary skill in the art would ignore these explicit teachings of Hattori and carve the card with notches, thereby destroying the protective layer and destroying the objective of “excellent smoothness.” Regardless of whether or not Okada teaches what the Examiner asserts, the Examiner is suggesting to modify Hattori in direct contradiction to the express teachings of Hattori. Such a modification cannot be held obvious since the Examiner has the advantage of hindsight based on Applicant’s current invention. Accordingly, Applicant respectfully submits that Hattori cannot be modified as proposed by the Examiner to render claim 1 obvious and, therefore, submits that the rejection of claim 1 should be reconsidered and withdrawn.

Respectfully submitted,

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